

**REMARKS**

Claims 41-54 and 97 are subject to examination. The undersigned appreciates the interview with the examiner on August 3, 2007. The indefiniteness rejections were discussed during the interview and the examiner stated that amendment of the claims as herein would further prosecution of the application. Prior art was not discussed.

Claim 41 has been amended to include features present in the dependent claims. Support for the temperature range of about 0°C to about 30°C can be found at Page 19, Line 19. Claim 51 has been amended to recite a temperature below about 40°C, for which support can be found at top of Page 21. Claim 53 has been amended to recite recovery in less than about 5 hours, for which support can be found at Page 18, line 15. Per the interview with the Examiner, it is believed that all of the 112 rejections are moot in light of the above amendments.

The claims have also been rejected for double patenting. All of the rejections are provisional rejections and, thus, the Applicants will defer filing a terminal disclaimer to the time where at least one claim is deemed allowable.

The Applicants note that some of the rejections are for statutory double patenting. The statutory double patenting rejections are in light of claims of 10/693166 and 10/746697. The claims in those applications are product claims, whereas the claims in this application are product by process claims. The Applicants concede that product by process claims are construed by the USPTO as product claims, but this construction should not bar the Applicants from claiming crystalline Form U in a multitude of ways. It is respectfully requested that the rejection be modified to an obviousness type double patenting rejection for the reasons set forth below.

An applicant has the right to claim an invention in a reasonable number of ways.

See *In re Chandler*, 319 F.2d 211, 225, 138 U.S.P.Q. 138, 148 (CCPA 1963):

“[A]pplicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged.”

The applicants right to claim the invention in a reasonable number of ways includes the right to use different terminology to define the exact same subject matter. See, e.g., *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F. 3d 1374, 1380, 77 U.S.P.Q. 2d 1988, 1993-1994 (Fed. Cir. 2006):

Different claims with different words can, of course, define different subject matter within the ambit of the invention. On the other hand, claim drafters can also use different terms to define the exact same subject matter. Indeed this court has acknowledged that two claims with different terminology can define the exact same subject matter. [underscoring added]

The applicant's right to claim an invention in a reasonable number of ways is especially strong in the case of claims to crystalline forms since the characterization of crystalline forms requires complicated analyses by such techniques as PXRD, single crystal X-ray diffraction, infrared spectroscopy, and raman spectroscopy. Small, inevitable uncertainties in the measurements produced by these techniques require that the applicant be granted latitude in the choice of language in order for the applicant to have a fair opportunity to properly capture the invention in the claims.

According to MPEP 804, a reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other?

Each of pending claims differs in scope from the claims of 10/693166 and 10/746697. In determining that the claims have the same scope, the Office Action ignores the different language used by the different claims and the different scopes thereby conferred on the claims by their use of different language. This is improper. It is settled law that the language of the claims determines the scope of the claims. See, e.g., *Home Diagnostics, Inc. v. Lifescan, Inc.*, 381 F. 3d 1352, 1355, 72 U.S.P.Q. 2d 1276, 1278 (Fed. Cir. 2004) “[T]he claim language itself governs the meaning of the claim;” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q. 2d 1573, 1576 (Fed. Cir. 1996): “[W]e look to the words of the claims themselves ... to define the scope of the patented invention.”

Focusing on the words used in the claims leads to a conclusion that each of the pending claims is of a different scope than the claims of 10/693166 and 10/746697. The pending claim 97 of this application is directed to a crystalline form of Form U obtained from different processes. This crystal form can be identified by any technique sufficient to identify the crystal form. Thus, to fall within the scope of claim 97, it is only necessary that a crystalline form be characterized by any characterization which identifies Form U to one of ordinary skill of art. In contrast, to fall within the scope of the applied claims of 10/693166 and 10/746697, specific peaks corresponding to those claimed need to be

identified. Thus, because the claims have different scope, a statutory double patenting is improper and should be modified to an obviousness-type double patenting.

### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request allowance of the pending claims. The Examiner is invited to contact the undersigned attorney to discuss any matter concerning this application. No fee is believed to be due for the submission of this response. Should any fees be required, the Commissioner is hereby authorized to charge any fees which may be necessary for consideration of this paper to Kenyon & Kenyon LLP Deposit Account No. 11-0600.

Respectfully submitted,

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